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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/812,627

03/20/2001

David Lawrence

3499-94

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28062

7590

09/08/2006

BUCKLEY, MASCHOFF, TALWALKAR LLC
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EXAMINER

SUBRAMANIAN, NARAYANSWAMY

ART UNIT

PAPER NUMBER

3628

DATE MAILED: 09/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/812,627

Applicant(s)

LAWRENCE ET AL.

Examiner

Narayanswamy Subramanian

Art Unit

3628

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5,7-21 and 26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5,7-21 and 26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2/21/2006</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This office action is in response to applicants' communication filed on June 19, 2006.

The examiner would like to thank the applicant for the information provided under 37 CFR 1.105 in their communication. Claims 1-5, 7-21 and 26 are pending in the application and have been examined. The rejections and response to arguments are stated below.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-5, 7-18 and 21 are rejected under 35 U.S.C. 102(e) as being fully anticipated by Basch et al (US Patent 6,119,103).

Claims 1, 16 and 21 Basch teaches a computer-implemented method, a computerized system, a computer executable program code residing on a computer readable medium for managing risk related to a financial transaction, the method comprising: gathering data into a computer storage, the data related to risk variables for a financial transaction (See Basch Abstract, Figure 1 and claims 1, 2); receiving information into the computer storage relating to details of a financial transaction (See Basch Abstract, Figure 1 and claims 1, 2, 19 and 29); structuring the received information received with a processor, according to a risk quotient criteria associated with at least one of a legal, financial, regulatory, and reputational risk (See Basch Abstract, Figure 1 and claims 1-7); and generating with the processor, a risk quotient comprising at least one of a

scaled numeric value and a scaled alphanumeric value based on the structured information and the gathered data (See Basch Abstract, Figure 1 and claims 1, 2, 19 and 29). The risk score is interpreted to include a risk quotient and the score is interpreted to include at least one of a scaled numeric value and a scaled alphanumeric value. Communication network, executable software stored on the server and executable on demand are inherent in the disclosure of Basch.

Claim 2, Basch teaches the step of generating a suggested action responsive to the risk quotient (See Basch claim 1). The step of transmitting the score to an account issuer based on the score is interpreted to include the step of generating a suggested action responsive to the risk quotient.

Claim 3, Basch teaches the steps of storing the information received, the risk quotient and the suggested action; and generating a diligence report referencing the stored information. (See Basch claims 3-7 and Column 10 lines 24- 32 and 55-60) The reports are interpreted to include diligence reports also.

Claim 4, Basch teaches the step wherein the diligence report comprises the information received relating to details of the financial transaction and actions taken responsive to the risk quotient. (See Basch Column 13 lines 26-62) The format of the alerts and reports are interpreted to include details of the financial transaction and actions taken responsive to the risk quotient.

Claim 5, Basch teaches the step wherein the suggested action is additionally responsive to the information received. (See Basch Column 8 lines 2-12). The dispute action is interpreted to include action is additionally responsive to the information received.

Claim 7, Basch teaches the step wherein the suggested action comprises refusing to perform a transaction. (See Basch claim 6). Denying authorization request is interpreted to include the step of refusing to perform a transaction.

Claim 8, Basch teaches the step wherein the suggested action comprises refusing to perform a transaction. (See Basch claim 6 and Column 11 lines 3-5). The step of refusing to perform a transaction is interpreted to include the step of blocking acceptance of an account.

Claim 9, Basch teaches the step wherein the suggested action comprises notifying an authorized private or public data services. (See Basch Column 9 line 62 - Column 10 line 3) The authorized private or public data services are interpreted to include an authority.

Claim 10, Basch teaches the step wherein the information received comprises the identity of a high-risk entity and the high-risk entity's relationship to an account holder. (See Basch Column 12 lines 47-52 and Column 13 lines 40-49)

Claim 11, Basch teaches the step wherein the information received comprises the identity of public agencies. (See Column 6 lines 24- 31) The public agencies are interpreted to include a secrecy Jurisdiction.

Claim 12, Basch teaches the step wherein the information received is gathered electronically. (See Basch Column 8 lines 20-22 and Column 8 line 60 -Column 9 line 10)

Claim 13, Basch teaches the step of aggregating risk quotients relating to a financial institution to assess a level of identified risk to which the financial institution is exposed. (See Basch Column 5 line 62 -Column 6 line 8).

Claim 14, Basch teaches the step wherein scores are generated for transactions. (See Basch Column 17 lines 9-11) The scores are interpreted to include an average risk quotient associated with a transaction.

Claim 15, Basch teaches the step wherein the financial transaction comprises opening a financial account. (See Basch Column 11 lines 3-5).

Claim 17, Basch teaches a system wherein the information is received via an electronic feed. (See Basch Column 8 lines 20-22 and Column 8 line 60 -Column 9 line 10)

Claim 18, Basch teaches a system wherein the information received is generated by a public agency. (See Column 6 lines 24- 31) The public agencies are interpreted to include a government agency also.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 19, 20 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Basch et al (US Patent 6,119,103).

Claims 19 and 20, Basch teaches a method and system of claims 1 and 16 as described above.

Basch fails to explicitly teach the steps wherein the network access device is a personal computer or a wireless handheld device and the risk quotient is indicative of an amount of money to defend an adverse position or a fine.

Official notice is taken that using a personal computer and/or a wireless handheld device to access networks are old and well known in the art. These devices allow the user to efficiently and rapidly communicate with the network. Also risk ratings indicative of liability risk (which includes an amount of money to defend an adverse position or a fine) are old and well known. These ratings help an insurer determine the premiums for underwriting the risk and for a user to determine if the risk is worth insuring.

It would have been obvious to one with ordinary skill in the art at the time of invention to include a personal computer and/or a wireless handheld device to the disclosure of Basch. The combination of the disclosures taken as a whole suggests that it would have helped the user facilitate faster and more efficient communication with the network and also determine if the risk is worth insuring

Response to Arguments

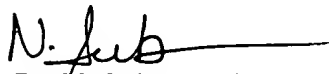
6. Applicant's arguments with respect to pending claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Narayanswamy Subramanian whose telephone number is (571) 272-6751. The examiner can normally be reached Monday-Thursday from 8:30 AM to 7:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung Sub Sough can be reached at (571) 272-6799. The fax number for Formal or Official faxes and Draft to the Patent Office is (571) 273-8300.

Art Unit: 3628

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PMR or Public PAIR. Status information for unpublished applications is available through Private PMR only. For more information about the PMR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "N. Sub", followed by a horizontal line extending to the right.

Dr. N. Subramanian

September 1, 2006